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REMARKS/ARGUMENTS

Favorable consideration and allowance of the instant application is respectfully requested in view of the following remarks.

Claim 25 was amended in order to correct an error in step sequence. No new matter is thought to be introduced thereby.

The Examiner's rejections, as they pertain to the patentability of the claims, are respectfully traversed.

Claims 25-37 are rejected under 35 U.S.C. § 112, first paragraph. This rejection is respectfully traversed for the following reasons.

The Examiner contends that the specification fails to contain support for the claimed order of steps (e) and (f). Claim 25 has been amended in order to correct the sequence order error identified by the Examiner. Accordingly, reconsideration and withdrawal of this objection is respectfully requested.

Claims 25-33 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over McCurry et al. (US 4,950,743). This rejection is respectfully traversed for the following reasons.

Initially, Applicant would like to note that it is clear in the law that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure [underline emphases added]. *Manual of Patent*

Examining Procedure, Rev. 3, July 1997, § 2142, pages 2100-108.

The '743 reference **admittedly** fails to teach or suggest **many** of the claimed elements of the present invention as is stated by the Examiner throughout the present office action In an effort to overcome this admitted lack of teaching or suggestion, the Examiner contends that all of these claim limitations would nevertheless be obvious to those of ordinary skill in the art for reasons which are not of record. The purpose of each of Applicant's claimed process limitations is identified in Applicant's specification. The Examiner has merely taken Applicant's outlined purpose for said limitations and concluded that all of reasons for employing Applicant's claim elements would blanketly be obvious to the routineer for the same reasons delineated by Applicant in its specification. Applicant, however, disagrees with the Examiner's contention for the following reasons.

First, it is well settled in the law that the mere allegation that the differences between the claimed subject matter and the prior art are obvious does not create a presumption of unpatentability which forces an applicant to prove conclusively that the Patent Office is wrong. See *In re Soli*, 137 USPQ 797 (CCPA 1963). The ultimate legal conclusion of obviousness must be based on facts or records, not on the Examiner's unsupported allegation that a particular modification is known and therefore obvious. Subjective opinions are of little weight in determining obviousness. See *In re Wagner et al.*, 152 USPQ 552 (CCPA 1967). The Examiner's conclusion of the obviousness of the claimed limitations are not drawn from any teaching or suggestion contained in the '743 reference. No facts or records found in the prior art have been offered by the Examiner in support of the finding of prima facie obviousness. The Examiner's basis for obviousness stems from Applicant's specification, not from the prior art.

Secondly, it has been held that, "The Patent Office ... may not, because it may **doubt** that the invention is patentable, resort to speculation, unfounded assumptions or hindsight to supply deficiencies in its factual basis." In re Warner, 154 USPQ 173, 178

(CCPA 1967). Applicant respectfully submits that the Examiner's findings are based on the **assumption** that Applicant's reasons for employing the claimed elements would also be a routineer's reasons as well. Unfortunately, prima facie obviousness may not be based on assumption and speculation. Since the '743 reference admittedly fails to contain any teaching or suggestion relating to the use of those claimed elements enumerated by the Examiner, i.e., the use of glucose syrup; the use of glucose syrup having the claimed solids content; etc , one of ordinary skill in the art has no reason to be motivated to modify the teachings of this reference in the manner asserted by the Office.

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 25 and 34-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over McCurry et al. (US 4,950,743) in view of Grutzke (US 5,648,475). This rejection is respectfully traversed for the following reasons.

The shortcomings associated with the teaching of the '743 reference are as outlined above, and admitted to by the Examiner. The '475 reference is cited merely for its alleged teaching concerning the use of a cascade of reactors. However, based on the shortcomings of the '743 reference, even if the '475 reference were combined with the '743 reference, a prima facie case of obviousness would nevertheless fail to be established since all of the claim limitation are neither taught nor suggested by either prior art reference. See, *MPEP*, section 2142, pages 2100-108.

Moreover, the reasons for employing the allegedly taught cascade reactors of the '475 reference, in combination with the '743 reference are not found in either of the prior art references, but rather, in Applicant's specification. Unfortunately, prima facie obviousness cannot be based on the assumption that an Applicant's reasons for using certain claim limitations are automatically obvious to those of ordinary skill in the art.

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal

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of this rejection is respectfully requested.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

It is believed that the foregoing reply is completely responsive under 37 CFR 1.111 and that all grounds for rejection are completely avoided and/or overcome. A Notice of Allowance is therefore earnestly requested.

The Examiner is requested to telephone the undersigned attorney if any further questions remain which can be resolved by a telephone interview.

Respectfully submitted,

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Enc.: Version With Markings To Show Changes Made

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

25. (First amended) A process for making alkyl and/or alkenyl oligoglycosides comprising:

(a) providing a glucose sirup;

(b) providing a fatty alcohol;

(c) combining the glucose sirup with the fatty alcohol in order to form a glucose sirup/fatty alcohol suspension;

(d) providing an acidic catalyst;

(e) [adding the acidic catalyst to the glucose sirup/fatty alcohol suspension;

(f)] drying the glucose sirup/fatty alcohol suspension at a temperature gradient of from about 70 to 120°C to form a dried glucose sirup/fatty alcohol suspension,

(f) adding the acidic catalyst to the dried glucose sirup/fatty alcohol suspension; and

(g) acetalizing the dried glucose sirup/fatty alcohol suspension containing the acidic catalyst to form the alkyl and/or alkenyl oligoglycosides.